

REMARKS

I. Amendments to Specification and Drawings

By this amendment, Applicant has included a brief, descriptive, and technically accurate title on the top portion of the first page of the specification, as requested by the Examiner. Further by this amendment, Applicant has included an Abstract on a separate sheet, as requested by the Examiner. Furthermore, this amendment replaces Figure 1 to include pertinent information, as requested by the Examiner.

II. Amendments to Claims

By this amendment, Applicant has canceled claims 1-15 and added new claims 16-21. Applicant notes that support for claims 16-21 may be found at least in now canceled claims 1 and 4-8. Claims 16-21 are currently pending. Of these, claim 16 is independent.

III. Arguments

A. Claim Rejections - 35 U.S.C. § 112

Claims 2 and 9-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. By this amendment, Applicant has canceled claims 2 and 9-15. In addition, new claims 16-21 correspond to now canceled claims 1 and 4-8 and therefore do not recite elements cited by the Examiner as being indefinite. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 112.

B. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,669,730 to Small ("Small")¹. Applicant has, by this amendment, canceled claims 2-3 and 9-12. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 103(a) as to these claims. Thus, new claims 16-21, corresponding to now canceled claims 1 and 4-8, stand rejected under 35 U.S.C. § 103(a).

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

¹ The Office Action sets forth many characterizations of the cited reference. Applicant discusses selected ones of these characterizations in this Response. However, the lack of discussion does not indicate that Applicant agrees with the characterizations set forth in the Office Action.

The Office Action has failed to establish a *prima facie* case of obviousness for at least the reason that Small and the Office Action's "Official Notice" fail to teach or suggest each and every element of claim 16².

1. Claims 16-21

Claim 16 recites, among other things: "adding a percentage of said purchase amount to a jackpot total associated with the electronic data manipulation system." Small and the Office Action's "Official Notice" fail to teach or suggest at least this element of claim 16.

The Office Action concedes that Small fails to disclose this element. See Office Action, page 5. The Office Action further takes "Official Notice" that it is common practice to "give an incentive to a customer during a transaction at a POS." See Office Action, page 5. The Office Action describes a "retailer or merchant [that] will compute from a customer's bill or balance due . . . a certain percentage savings, due to the customer, if the customer's transaction amount falls within one or more preset thresholds (volume purchase)." See Office Action, page 5. The Office Action also describes a "manufacturer or retailer [that] may provide an incentive (dollar amount) to a customer for performing a particular task and wherein this incentive or dollar amount is invested at an investment firm on behalf of the customer." See Office Action, page 6.

Applicant respectfully traverses the "Official Notice" and requests evidence, such as an affidavit, that "adding a percentage of said purchase amount to a jackpot total

² New claim 16 recites elements corresponding to now canceled claim 1.

associated with the electronic data manipulation system” is well known in the art.

“When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner.” See M.P.E.P. § 2144.03 (8th ed. 2001).

Moreover, assuming the “Official Notice” can be supported by an affidavit or other evidence, such descriptions do not provide motivation to combine with Small to produce a method including, *inter alia*, the step: “adding a percentage of [a] purchase amount to a jackpot total associated with [an] electronic data manipulation system,” as recited in claim 16. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” See M.P.E.P. § 2143.01 (8th ed. 2001). The Office Action asserts a motivation to combine without support from the prior art. See Office Action, page 6. Because Small and the Office Action’s “Official Notice” contain no suggestion or motivation to combine the references in a manner resulting in the claimed invention, claim 16 is allowable.

Finally, Applicant notes that Small appears to be directed toward promoting or encouraging the use of financial institution transacting devices, such as ATMs and Point of Sale devices. See Small, col. 2, lines 40-51. In contrast, the present invention is concerned with encouraging retail spending, not simply rewarding consumers for using ATMs or Point of Sale devices.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 102(b). Claims 17-21 depend from and add additional features to independent claim 16. Accordingly, these claims are allowable for at least the reasons set forth above.

Conclusion

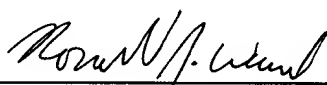
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this reply and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: November 17, 2004

By:  Reg. No. 54,870
for David W. Hill
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Attachments: **Abstract**
 Replacement Drawing Sheet